

REMARKS

Initially, Applicant thanks the Examiner for graciously clarifying his rejections to Applicant by telephone on September 16, 2003.

Claims 1-50 are pending in this application, with claims 1, 6 and 28 being independent. Claims 6, and 28 have been amended to overcome the examiner's rejections, while claims 7, 10-13, 15-18, 21-23, 25-26, 29, 32-34, 36-40 and 42-50 have been amended to claim more clearly the desired subject matter. Claims 1-5, 8-9, 30-31, 35 and 41 have been canceled. New claims 51-53 have been added.

Conflicting Claims

The Examiner alleges that claims 1-50 of this application conflict with claims of record of Application No. 09/750,028 also filed by Applicant. Nevertheless, a clear line of demarcation exists between the two applications. For example, all claims of the present application recite a compact disk holder having at least one spoke, a feature not present in any of the claims of Application No. 09/750,028.

Provisional Non-Statutory Double Patenting Rejection

Claims 1-50 stand provisionally rejected as obvious over claims of record of Applicant's co-pending Application No. 09/750,028. Without conceding obviousness, and to the extent that neither set of claims is materially altered in scope, Applicant agrees to file a terminal disclaimer should the currently amended claims of the present application issue after issuance of the claims of Application No. 09/750,028.

Written Description Rejections

Claims 2-4 and 6-50 stand rejected for failing to comply with the written description requirement. Specifically, either directly or by dependency, each of claims 2-4 and 6-50 require at least one spoke that is "discontinuous around a perimeter of the disk securing member"—language that the Examiner states cannot be understood. The rejection is obviated by

cancellation of claims 2-4, 8-9, 30-31, 35 and 41, and by amendment of claims 6 and 28, from which claims 7, 10-27, 29, 32-34, 36-40, and 42-50 depend, to remove the language "discontinuous around a perimeter of the disk securing member." Applicant, therefore, respectfully requests withdrawal of the written description rejection of claims 6-7, 10-18, 20-29, 32-34, 36-40, and 43-50.

Applicant emphasizes that this amendment is made for purposes of clarity only and does not alter the scope of the amended claims. The language "discontinuous around a perimeter of the disk securing member" was intended to describe expressly an inherent structural feature. Namely, because the claimed structure has one or more spokes, it is inherent that discontinuities exist between respective sides of the one or more spokes. The gap 160 shown in FIG. 1 is an example of such a discontinuity.

Indefiniteness Rejections

Claims 2-4 and 6-50 stand rejected as indefinite based on the same claim language ("discontinuous around a perimeter of the disk securing member") for which the claims also were rejected for failing to satisfy the written description requirement. Applicant's cancellation of claims 2-4, 8-9, 19, 30-31, 35 and 41-42, and amendment of claims 6 and 28, from which claims 7, 10-18, 20-27, 29, 32-34, 36-40 and 43-50 depend, also obviate this indefiniteness rejection, as they did the written description rejection addressed above.

Claim 13 stands rejected as indefinite based additionally on use of the phrase "structured and arranged," which the Examiner states does not allow the claimed structure to be determined. To address this rejection, Applicant has amended claim 13 and similar claim 37 to recite a "spacing structure," thus eliminating the phrase "structured and arranged" from those claims. The amendment of claims 13 and 37 also cures any deficiency inherited by claims 14, 15, 38 and 39 which depend from claims 13 and 37. Accordingly, Applicant requests withdrawal of the indefiniteness rejections of claims 13 and 37, and of the claims that depend from them.

Claims 17, and 19 stand rejected as indefinite additionally for claiming by reference to unclaimed subject matter: "a jewel case typically used to store compact discs" and a "digital

versatile disc," respectively. For improved clarity, Applicant has amended claim 17 to recite the claimed subject matter in terms of express numerical dimensions of a "jewel case" rather than by reference to the "jewel case." Applicant also has canceled similar claim 41. With respect to claims 19 and 42, the "digital versatile disc" standard is well known in the art and is distinct from the compact disc standard. The reference by claims 19 and 42 to the known but unclaimed DVD standard does not render the claims indefinite, but, rather, clarifies the scope of the claimed subject matter. See, e.g., Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565 (Fed. Cir. 1986) (finding definite a claim for a pediatric wheelchair "so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats"). Consequently, Applicant requests withdrawal of the indefiniteness rejection of claims 17, 19 and 42.

For the reasons discussed above, Applicant respectfully requests withdrawal of the indefiniteness rejections of claims 6-7, 10-29, 32-34, 36-40, and 42-50.

35 U.S.C. § 102(b) Rejection

Claims 1-50 stand rejected as anticipated by either Gelardi (U.S. Patent No. 5,284,243) or Brosmith (U.S. Patent No. 5,651,458). This rejection is obviated by amendment of claims 6 and 28, and by cancellation of claims 1-5, 8-9, 30-31, 35 and 41.

Independent claim 6 recites a compact disk holder having a first side and a second side connected together to move between closed and open positions. A window is included that is smaller than either the first side or the second side and that provides visibility within the compact disk holder when the first side and the second side are in the closed position. The compact disk holder also includes a disk securing member to engage a compact disk. At least one spoke extends radially from the disk securing member toward the second side. Amended dependent claim 10 (in view of claim 7) recites, in addition, that the window generally is congruent to, and superimposed over, a portion of the compact disk unobstructed by the at least one spoke (e.g., the portion of the compact disk that would be viewable through the gap 160 of FIG. 1).

Gelardi, on the other hand, discloses a jewel box having a base and a lid that are hinged together to open and close. See Gelardi at FIG. 2. A disk retaining tray fits within the jewel box

to engage compact disks stored therein. See id. The tray includes engagement means for engaging two compact disks and four spokes configured radially with respect to the perimeter of the engagement means. See id. Gelardi, however, does not describe or suggest a window smaller than the first side or the second side as required by amended independent claim 6. Instead, rather than using a window, Gelardi teaches that the jewel box is manufactured of clear plastic material, Gelardi at 4:68-5:3, thus removing the need for any form of window. In sum, Gelardi teaches away from providing a window smaller than the first side or the second side. Gelardi also cannot be said to disclose a window congruent to, and superimposed over, a portion of the compact disk unobstructed by the at least one spoke. Lacking disclosure of the required window, Gelardi cannot anticipate amended claim 6.

Brosmith, for its part, discloses a storage device constructed of square sheet material but lacking a lid or a base connected together to move between closed and open positions. See Brosmith at 3:45-49, FIG. 1. Brosmith also discloses that the storage device may be mounted within a storage box, but describes only that the storage box includes a rail assembly on which the storage device may be mounted. See Brosmith at 3:59-4:2. With respect to the storage device, the storage device includes a disk retention mechanism on one face of the sheet material, while on the other face corner blocks with retaining slots are provided to retain an informational pamphlet of the compact disk. See Brosmith at 3:49-4:12, 4:44-65. Alternatively, a spoked attachment for retaining a second compact disk may be substituted for the informational pamphlet. See Brosmith at 5:21-6:4.

Brosmith does not describe a first side and a second side connected together to move between closed and open positions. Brosmith also fails to disclose a window of any kind. Failing, moreover, to disclose the first side and the second side, Brosmith cannot disclose a window smaller than the first side or the second side and configured to view within the compact disk holder when the first side and the second side are in the closed position as required by amended independent claim 6. Lacking disclosure of the first side, the second side, or the required window, Brosmith cannot anticipate amended claim 6.

For at least these reasons, claim 6 is allowable over either Gelardi or Brosmith. Claims 7, 10-27 and new claims 51-53 depend from claim 6 and are allowable for at least the reasons given for claim 6. Applicant requests, therefore, reconsideration and withdrawal of the § 102(b) rejections of those claims.

Independent claim 28 is directed toward a method of distributing marketing materials to an intended recipient using a compact disk holder defined by the same limitations recited by claim 6 including a window smaller than the first side or the second side of the compact disk holder. Neither Gelardi nor Brosmith describe or suggest this limitation, as discussed previously with respect to claim 1. For at least this reason, claim 28 is allowable over both Gelardi and Brosmith.

Claims 29, 32-34, 36-40, and 42-50 depend from claim 28 and are allowable for at least the reasons given for claim 28.

35 U.S.C. § 103(a) Gelardi/Brosmith Rejection

Claims 1-50 stand rejected under § 103(a) as allegedly unpatentable over either Gelardi or Brosmith. This rejection is obviated by the amendments to independent claims 6 and 28, and by cancellation of claims 1-5, 8-9, 30-31, 35 and 41.

As described above, Gelardi discloses a jewel box having a disk retaining tray to engage two compact disks. See Gelardi at FIG. 2. Gelardi, however, does not disclose or suggest a window smaller than the first side or the second side of a compact disk holder as required by amended independent claims 6 and 28. In fact, as described above, Gelardi teaches that the jewel box is manufactured of transparent material, thus eliminating the need for a window. Rather than motivating provision of a window smaller than either the first side or the second side, Gelardi teaches that a compact disk holder may be manufactured to not require windows at all. In short, Gelardi teaches away from the present invention. In addition, Gelardi cannot be said to disclose or suggest a window congruent to, and superimposed over, a portion of the compact disk unobstructed by the at least one spoke as further required by dependent claim 10.

Brosmith, also described above, discloses a sheet style storage device with a disk retention mechanism on one face, while the opposite face includes corner blocks with retaining slots to retain an informational pamphlet or an attachment for holding an additional compact disk. See Brosmith at 4:3-12, 5:21-6:4, FIG. 1. Brosmith, however, does not disclose or suggest a window smaller than the first side or the second side of the compact disk holder and configured to view within the compact disk holder when in the closed position. In fact, as described above, Brosmith fails entirely to disclose or suggest a window of any kind. And lacking the required first side and second side connected together to move between closed and open positions Brosmith does not disclose or suggest a window smaller than the first side or the second side and configured to view within the compact disk holder when the first side and the second side are in the closed position as required by amended independent claim 6.

In sum, neither Gelardi nor Brosmith disclose a window smaller than the first side or the second side of the compact disk holder as required by amended claims 6 and 28, nor provide motivation to include such a window. Due to their failure to teach or suggest the above noted features of amended claims 6 and 28, either alone or in combination, it is respectfully submitted that Gelardi and Brosmith fail to establish a *prima facie* case of obviousness with regards to claims 6 and 28. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 7, 10-27, 29, 32-34, 36-40, 42-50 and new claims 51-53 depend from claims 6 and 28 and are allowable for at least the reasons given for claims 6 and 28.

For the reasons discussed above, Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 6, 7, 10-29, 32-34, 36-40, and 42-50.